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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,934	07/15/2003	Yasuo Okada		6832
26021	7590	09/01/2004	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611				LEE, HSIEN MING
		ART UNIT		PAPER NUMBER
				2823

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/619,934	OKADA, YASUO	
	Examiner	Art Unit	<i>AN</i>
	Hsien-Ming Lee	2823	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 June 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

HSIEN-MING LEE
PRIMARY EXAMINER


Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION***Remarks***

1. The objection to drawings is withdrawn.
2. Claims 1-16 are pending in the application.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5 and 8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Yu et al. (US 6,319,784).

In re claims 1-5, Yu et al. teach the claimed method of manufacturing method of a semiconductor device, comprising:

- forming a buried insulating film 12 in a semiconductor substrate 10 (Fig. 1);
- forming semiconductor elements 14/16 isolated by the buried insulating film 12 (Fig. 1);
- cleaning a surface side of the semiconductor substrate with a cleaning solution, i.e. using HF to clean native oxide 28 (col. 2, line 66 through col. 3, line 7); and
- covering a surface side of the buried insulating film 12 with a protective film 26 (silicon nitride) before the step of cleaning the surface side of the

semiconductor substrate 10, wherein a protective film 26 is resistant to the cleaning solution.

In re claims 8-9, Yu et al. also teach a semiconductor device, comprising:

- a buried insulating film 12 which is formed in a semiconductor substrate 10;
- semiconductor elements 14/16 which are formed on the semiconductor substrate 10 and which are isolated by the buried insulating film 12; and
- a protective film 26 (silicon nitride) which covers all of a surface side of the buried insulating film 12 but which does not cover at least a region in which a salicide metal layer 32 of the semiconductor element is formed (Fig.6), wherein the protective film 26 is resistant to a hydrofluoric acid based solution (HF).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 7, 10 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu et al. in view of Kuroda et al. (US 6,506,647).

In re claims 6 and 10, Yu et al. also teach forming a sidewall 20 (silicon nitride) on a side portion of a gate electrode 16 and wherein the sidewall 20 and the protective film 26 are the same material (silicon nitride) except that the gate electrode is of the MISFET.

However, the teachings of Yu et al. is a illustrative rather than restrictive (col. 4, lines 17-20). The semiconductor elements in Yu et al. are composed of gate electrode 16, gate insulating layer 14 and dielectric sidewall spacers 20, which is similar to the structure of MISFET, as evidenced by Kuroda et al. (Fig. 5), wherein Kuroda et al. teach MISFET Qn1 composed of gate insulating layer 8b, gate electrode 9a and dielectric sidewall spacers 12s (silicon nitride).

Therefore, it would have been obvious to one of the ordinary skill in the art, at the time of the invention was made, to apply the teachings of Yu et al. in MISFET of Kuroda et al. for a reasonable expectation of success because the semiconductor elements in both Yu et al. and Kuroda et al. are similar. By depositing the silicon nitride on the buried insulating film as the protecting layer, the buried insulating film would not suffer etching attack during the cleaning step.

In re claim 7, by applying the teachings of Yu et al. in forming MISFET, one of the ordinary skill in the art would have recognized that Yu et al. in view of Kuroda et al. also teach forming a salicide metal layer 32 on the gate electrode 16, a source diffusion region 22, and a drain diffusion region 22 (Fig.6 in Yu et al.) of the MISFET (i.e. when the semiconductor element in Yu is replaced by a MISFET) after the step of cleaning the surface side of the semiconductor substrate because the only difference is that Yu et al. do not expressly teach that the electrode 16 is an electrode of MISFET. However, this deficiency is remedy by Kuroda et al., as stated above.

With the combined teachings of Yu et al. and Kuroda et al., as stated above, the limitations as recited in claims 11-13 are also met because all limitations of claims 11-13 are same as that in claims 8-10.

In re claims 14 and 16, the combination of Yu et al. and Kuroda et al. also teach the claimed limitations because Kuroda et al. teach the semiconductor element is MISFET, which remedies the deficiency in Yu et al.; and Yu et al. teach that the protective film 26 is formed on the top of a gate electrode of 16 the semiconductor element.

In re claim 15, Kuroda et al. would remedy the deficiency in Yu et al. because Kuroda et al. teach forming STI 5 to electrically isolate MISFET, wherein the STI is an art recognize equivalence to field oxide in Yu et al. One of the ordinary skill in the art would have been motivated to replace the field oxide of Yu et al. with the STI of Kuroda et al., since STI is a good alternative electrical isolation to field oxide for transistor.

Response to Amendment

7. The amendment filed 6/18/2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: “the top of the protective film is lower than the top of the semiconductor elements.” (Emphasis added)

The originally filed written specification fails to support the aforementioned limitation. Although Figure 8 illustrates the top surface of film 154 being lower than top surface of 160 and 170 of semiconductor elements, there is **no** any written description supports the assertion and further demonstrates the criticality of the amended limitation.

In addition, the Figure 8 cannot be treated in scale as to the height of the protective film 154 and the semiconductor elements 160 and 170 illustrated since the written description is **completely silent** as to the above limitation. Thus, the amended limitation has **not** been treated on its merits.

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

8. Applicant's arguments filed 6/18/2004 have been fully considered but they are not persuasive.

Applicant's argument is on the ground that Yu et al. do not teach "the top of the protective film is lower than the top of the semiconductor elements." (third paragraph, page 9).

However, the aforementioned limitation has been found as new matter and thus not been treated on its merits. Thus, the rejections under the teachings of Yu et al. and Kuroda et al. are deemed proper.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sakui et al. to US 6,411,548 teach that element isolation layers may be field oxide films or layers having an STI structure.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hsien-Ming Lee whose telephone number is 571-272-1863. The examiner can normally be reached on Tuesday-Thursday (8:00 ~ 6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri can be reached on 571-272-1855. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2823

Hsien-Ming Lee
Primary Examiner
Art Unit 2823

August 31, 2004

HSIEN-MING LEE
PRIMARY EXAMINER